

## REMARKS

In the Office Action, claims 74-77 are rejected under 35 U.S.C. §102 in view of U.S. Patent No. 4,443,441 (Galin). Applicant believes that this rejection is improper as detailed below.

At the outset, the Patent Office alleges that "there is no evidence of record to demonstrate such advantage" of the claimed invention. Contrary to the Patent Office position, Applicant has conducted experiments as detailed in the specification which demonstrate the enhanced benefits to vision in dim light associated with the claimed phentolamine-based formulation as compared to other alpha-1 antagonist-based formulations. See, Applicant's Specification, Examples 1 and 2 and Tables 1 and 2, beginning on page 24. Moreover, such unexpected results are further supported by the Affidavit of Gerald Horn, M.D. that was previously submitted in this case.

While Galin generally describes an ophthalmic solution that contains alpha-adrenergic blocking agents and further provides a list of six possible agents, the preferred and only working example is directed to a solution that contains thymoxamine, and thus Galin fails to recognize the benefits of the claimed ophthalmic night vision formulation with phentolamine. Moreover, the improved effect of a phentolamine-based solution on night vision as claimed, let alone phentolamine in an ophthalmic artificial tear solution as further defined in claim 76, should not be deemed an inherent property of the ophthalmic solution described in Galin. Again, the preferred solution in Galin is thymoxamine in purified water as detailed in the only working example. Therefore, Applicant does not believe that Galin provides sufficient teaching to render unpatentable the phentolamine-based ophthalmic solution that improves night vision as defined in presently pending claims 74-77. For at least these reasons, Applicant respectfully submits that the anticipation rejection should be withdrawn.

Further, claims 74-77 are provisionally rejected under 35 U.S.C. §101. Considering this rejection is provisional, Applicant elects to address this rejection upon allowance of at least one of the present application and U.S. Patent Application No. 10/799,299 to the extent even applicable at that time, and thus this response should be considered responsive to this provisional rejection at this stage.

Accordingly, Applicant respectfully submit that the present application is in condition for allowance.

The Commissioner is hereby authorized to charge deposit account 02-1818 for any fees which are due and owing.

Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY 

\_\_\_\_\_  
Thomas C. Basso (46,541)  
Customer No. 24573

Date: February 13, 2009